APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR		ATTORNEY DOCKET NO.
09/143,967	08/31/98	BERTMAN	R	RP9-95-017V

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EXAMINER
HUYNH, B

ART UNIT	PAPER NUMBER
2773	3

DATE MAILED: 08/02/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

1- File Copy

X Responsive to communication(s) filed on _Aug 31, 1998_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters,   **prosecution as to the merits is closed** in accordance with the practice under _Ex parte Quayle_ 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire _____3___ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

X Claim(s) _37-72_____ is/are pending in the applicat

    Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

X Claim(s) _37-72_____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

X See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

    ☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

        ☐ received.

        ☐ received in Application No. (Series Code/Serial Number) _____ .

        ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

    *Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

X Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

X Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

BA HUYNH
PRIMARY EXAMINER

— *SEE OFFICE ACTION ON THE FOLLOWING PAGES* —

DETAILED ACTION

Priority

1.   This application discloses and claims only subject matter disclosed in prior Application

No. 08/703,171, filed 8/22/96, and names an inventor or inventors named in the prior application.

Accordingly, this application may constitute a continuation or division. Should applicant desire to

obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120

and 37 CFR 1.78.

Double Patenting

2.   The nonstatutory double patenting rejection is based on a judicially created doctrine
grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or
improper timewise extension of the "right to exclude" granted by a patent and to prevent possible
harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.
Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686
F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619
(CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
        A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to
overcome an actual or provisional rejection based on a nonstatutory double patenting ground
provided the conflicting application or patent is shown to be commonly owned with this
application. See 37 CFR 1.130(b).
        Effective January 1, 1994, a registered attorney or agent of record may sign a terminal
disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3.   Claims 37-72 are rejected under the judicially created doctrine of obviousness-type double

patenting as being unpatentable over claims 1-36 of U.S. Patent No. 5,864,340, claims 1-26 of

US patent No. 5,805,159, and patented claims 1-20 of US patent No. 5,805,158. Although the

conflicting claims are not identical, they are not patentably distinct from each other because the

broaden claims 37-72 are covered by the patented claims.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

5.   Claims 37-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capps, US

patent #5,666,502, in view of US patent #5,367,619 (Dipaolo et al).

- As per claims 37,49,61: Capps teaches a handhold computer system comprising:

a housing, a processor mounted within the housing for processing digital data, a memory

for storing digital data, a display, an input digitizer, a control program stored in the memory for

processing of digital data (Figures 1, 2; Col. 4, line 39 - Col. 5, line 52). The system displays a

form defining data fields and supplies a list of possible data entry for a defined data field

(figure 5s). The list is derived from captured user inputs. Capps fails to clearly teach the entry of

data to the field (i.e., automatic entering data to the field without being selected by the user).

However, in the same art of electronic form data entry, Dipaolo et al teach the automatic filling a

data field ("fill in the blank") with an entry of the most possible data predicted by the system

(Col. 2, lines 50-55; Col 6, lines 31-38; Col 12, lines 1-12). Thus it would have been obvious to

one of ordinary skill in the art, at the time the invention was made, to combine Dipaolo's teaching

of automatic filling a data field to Capps for filling the data field with the most possible data entry

from the list. Motivation of the combining is for the advantage of automatic filling of the data

field without action by the user.

    - As per claims 38,50,62: The data entered is default value since it is subjected to be

modified (Dipaolo's col. 2, lines 52-55; col. 12, lines 1-12).

    - As per claims 39, 51,63: The default entry is selected from a predictive list based on a

pre-determined algorithm (Capps' figures 5B, 6A).

    - As for claims 40,41,52,53,64,65: Dipaolo et al teach the automatic filling a data field

("fill in the blank") with an entry of the most possible data predicted by the system (Col. 2,

lines 50-55; Col 6, lines 31-38; Col 12, lines 1-12)

    - As per claims 42, 43,54,55,66,67: Per Capps the most possible data entry can be selected

from the history list based on recency of use (Capps' figures 5B, 6A).

    - As per claims 44,56,68: The most possible data entry can be selected from the list based

on frequency of use (Capps' figures 5B, 6A).

    - As per claims 45,57,69: The most possible data entry can be selected from the list based

on a user selected weight determination of the recency and frequency of usage (Capps'

figures 5B, 6A).

- As per claims 46,58,70: The list comprises a leading portion based on the recency of use

and a trailing portion based on frequency of use (Capps' figure 5A; col. 11, lines 32-61).

- As per claims 47,59,71: Data entered in to the fields are captured and stored in the

history list (Capps' col. 2, lines 30-33; col. 10, lines 27-29; claim 2).

- As per claims 48,60,72:   Capps teaches a handhold computer system comprising:

a housing, a processor mounted within the housing for processing digital data, a memory

for storing digital data, a display, an input digitizer, a control program stored in the memory for

processing of digital data (Figures 1, 2; Col. 4, line 39 - Col. 5, line 52). The system displays a

form defining data fields and supplies a list of possible data entry for a defined data field

(figure 5s). The list is derived from captured user inputs. Capps fails to clearly teach the entry of

data to the field (i.e., automatic entering data to the field without being selected by the user).

However, in the same art of electronic form data entry, Dipaolo et al teach the automatic filling a

data field ("fill in the blank") with an entry of the most possible data predicted by the system

(Col. 2, lines 50-55; Col 6, lines 31-38; Col 12, lines 1-12). Thus it would have been obvious to

one of ordinary skill in the art, at the time the invention was made, to combine Dipaolo's teaching

of automatic filling a data field to Capps for filling the data field with the most possible data entry

from the list. Motivation of the combining is for the advantage of automatic filling of the data

field without action by the user. The default entry is selected from a predictive list based on a

pre-determined algorithm (Capps' figures 5B, 6A). Dipaolo et al teach the automatic filling a data

field ("fill in the blank") with an entry of the most possible data predicted by the system (Col. 2,

lines 50-55; Col 6, lines 31-38; Col 12, lines 1-12). Data entered in to the fields are captured and

stored in the history list (Capps' col. 2, lines 30-33; col. 10, lines 27-29; claim 2).

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7.   Claims 37 are rejected under 35 U.S.C. 102(b) as being anticipated by US patent

#5,390,281(Luciw et al).

        - As per claims 37,40,49,52,64,61: Luciw et al teaches a handhold computer system

comprising:

        a housing, a processor mounted within the housing for processing digital data, a memory

for storing digital data, a display, an input digitizer, a control program stored in the memory for

processing of digital data. The system displays a form defining data fields (col. 5, lines 51-59;

col. 10, lines 56-62; col. 18, lines 20-32), predicts user intent, and supply a data entry for a data

field (col. 16, lines 54 - col. 17, line 19).

        - As per claims 38,50,62: The data entered is default value since it is a hypothesis and

subjected for confirmation (col. 6, line 59 - col. 7, line 4; col. 14, lines 36-38).

- As per claims 39, 41,42,51,53,54,63,65,66: The default entry is selected from a predictive list based on a pre-determined algorithm (col. 11, line 65 - col. 12, line 2).

- As per claims 43,55,67: Per Luciw et al the most possible data entry can be selected from the history list based on recency of use (col. 14, lines 43-46; col. 16, lines 1-16).

- As per claims 44,56,68: The most possible data entry can be selected from the list based on frequency of use (col. 14, lines 40-43; col. 16, lines 1-16).

- As per claims 45,57,69: The most possible data entry can be selected from the list of weighted determination of the recency and frequency of usage (col. 14, lines 40-46; col. 16, lines 1-16).

- As per claims 47,59,71: Data entered in to the fields are captured and stored in the history list (Luciw et al' col. 2, lines 30-33; col. 10, lines 27-29; claim 2).

- As per claims 48,60,72:   Luciw et al teaches a handhold computer system comprising:

a housing, a processor mounted within the housing for processing digital data, a memory for storing digital data, a display, an input digitizer, a control program stored in the memory for processing of digital data. The system displays a form defining data fields (col. 5, lines 51-59; col. 10, lines 56-62; col. 18, lines 20-32), predicts user intent, and supply a data entry for a data field (col. 16, lines 54 - col. 17, line 19). The data entered is default value since it is a hypothesis and subjected for confirmation (col. 6, line 59 - col. 7, line 4; col. 14, lines 36-38). Data entered in to the fields are captured and stored in the history list (Luciw et al' col. 2, lines 30-33; col. 10, lines 27-29; claim 2).

Claim Rejections - 35 USC § 103

8.   Claims 46,58,70 are rejected under 35 U.S.C. 103(a) as being unpatentable over US

patent #5,390,281 (Luciw et al).

- As per claims 46,58,70: The history list is formed based on frequency and recency of use

(col. 14, lines 40-46; col. 16, lines 1-16), all possible user intents are prioritized. Luciw et al et al

fail to clearly teach that the giving more weight to the recency of usage such that the list

comprises a leading portion based on the recency of use and a trailing portion based on frequency

of use. However, giving more weight to the recency of usage would have been an obvious design

preference.

Inquires

        Responses to this action should be mailed to: Commissioner of Patents and Trademarks,
Washington, D.C. 20231. If applicant desires to fax a response, (703) 308-9051 may be used for
formal communications or (703) 308-6606 for informal or draft communications. NOTE: A
Request for Continuation (Rule 60 or 62) cannot be faxed.
        Please label "PROPOSED" or "DRAFT" for informal facsimile communications. For after
final responses, please label "AFTER FINAL" or "EXPEDITED PROCEDURE" on the
document.
        Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington. VA., Sixth Floor (Receptionist).
        Any inquiry concerning this communication or earlier communications from the examiner
should be directed to Huynh-Ba whose telephone number is (703) 305-9794. The examiner can
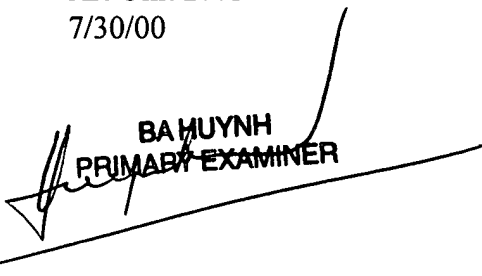normally be reached on Monday-Friday from 8.00AM to 4.30PM.
        If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,
Matthew Kim, can be reached on (703) 305-3821.

Art Unit: 2773

       All Internet e-mail communications will be made of record in the application file. PTO
employees do not engage in Internet communications where there exists a possibility that sensitive
information could be identified or exchanged unless the record includes a properly signed express
waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the
Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on
February 25, 1997 at 1195 OG 89.
       Any inquiry of a general nature or relating to the status of this application or proceeding
should be directed to the Group receptionist whose telephone number is (703) 305-3800.

Huynh-Ba
Primary Examiner
Art Unit 2773
7/30/00

BA HUYNH
PRIMARY EXAMINER